

Customer No. 22,582  
Application No. 09/673,476  
Attorney Docket No. 03495.0320  
(formerly 05394.0011)

**REMARKS**

Reconsideration of this application is respectfully requested.

Claims 1-52, 57, and 58 are canceled, and claims 53-56 are amended. Upon amendment, claims 53-56 are pending in the application.

Support for amended claims 53-56 can be found throughout the specification, for example, as follows:

<b><u>Claim</u></b>	<b><u>Support</u></b>
53	Original claim 11; page 10, ll. 32-35; page 12, l. 8 - page 13, l. 5.
54	Original claim 11; page 10, ll. 32-35; page 12, l. 8 - page 13, l. 5.
55	Original claim 11; page 10, ll. 32-35; page 12, l. 8 - page 13, l. 5.
56	Original claim 11; page 10, ll. 32-35; page 12, l. 8 - page 13, l. 5.

Applicants submit that these claim amendments are fully supported by the specification, do not introduce new matter or require a further search of the art, and respectfully request their entry.

**Claim Rejections under 35 U.S.C. § 112, Second Paragraph, Indefiniteness**

The Office rejected claims 53-58 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. (Office Action at item 4.)

In particular, the Office contends that the numbering system used in claims 53-58 is indefinite because it is "not with regard to SEQ ID NO: 1, which is the only reference

used in the claims." (Office Action at item 4.) Although Applicants have amended the claims in an effort to facilitate prosecution by providing "wherein SEQ ID NO: 1 consists of nucleotide 1,696,015 through nucleotide 1,708,746 of the *Mycobacterium tuberculosis* chromosome," Applicants respectfully traverse the contention that the numbering system was indefinite. According to the M.P.E.P., "[a] fundamental principle contained in 35 U.S.C. § 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art." M.P.E.P. § 2173.01.

The specification discloses that SEQ ID NO: 1 begins at its 5' end with nucleotide 1,696,015 of the *Mycobacterium tuberculosis* chromosome, and ends at its 3' end with nucleotide 1,708,746 of the *Mycobacterium tuberculosis* chromosome. (Page 10, lines 32-35.) The specification further identifies the positions of the 5' and 3' ends of the Open Reading Frames contained in the polynucleotide sequence of SEQ ID NO: 1 with reference to the *Mycobacterium tuberculosis* chromosome. (Pages 12, line 8 - page 13, line 5.) Thus both SEQ ID NO: 1 and the polynucleotides recited in the claims are referenced to the *Mycobacterium tuberculosis* chromosome. The M.P.E.P. states that "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: . . . The content of the particular application disclosure . . ." M.P.E.P. § 2173.02. Applicants thus submit that the metes and bounds of the numbering system as recited in the claims was definite.

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The Office also alleged that claim 53 is indefinite, as nucleotide 1,696,015 to 1,696,441 of the *Mycobacterium tuberculosis* chromosome is not taught to “comprise” an open reading frame. (Office Action at item 4B.) Applicants have amended claim 53 to eliminate this polynucleotide, and the rejection is now moot. Applicants thus request the withdrawal of the 35 U.S.C. § 112, second paragraph, indefiniteness rejection.

**Claim Rejections under 35 U.S.C. § 112, First Paragraph, Written Description**

In items 5 and 6, the Office rejected claims 57 and 58 under 35 U.S.C. § 112, first paragraph, for a lack of written description because it alleged that “[t]he claims are drawn to unspecified sequences with any magnitude or content that hybridize to any of the polynucleotides of SEQ ID NOS 53-56 under any (claim 57) as well as specified (claim 58) conditions.” Applicants have canceled claims 57 and 58, thus obviating the grounds of this rejection. Applicants retain the right to pursue these claims in a divisional application. Accordingly, Applicants request that this rejection be withdrawn.

**Claim Rejections under 35 U.S.C. § 102, Prior Art**

In item 8, the Office Rejected claim 53 under 35 U.S.C. § 102(b) as being anticipated by Brennan, U.S. Patent No. 5,474,796, because Brennan allegedly teaches “every possible trimer nucleic acid which are considered ‘fragments’ of SEQ ID NO: 1.” As amended, claim 53 does not recite fragments of SEQ ID NO: 1. Accordingly, Applicants respectfully request that the rejection be withdrawn.

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In item 9, the Office rejected claims 57 and 58 under 35 U.S.C. § 102(b) as being anticipated by Genbank accession number AD000001. Because claims 57 and 58 have been canceled, Applicants respectfully request that this rejection be withdrawn.

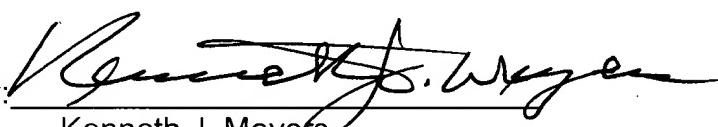
If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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